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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/630,607

07/29/2003

Paula M. McCready

IL-11032

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08/04/2006

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EXAMINER

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ART UNIT

PAPER NUMBER

1634

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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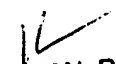
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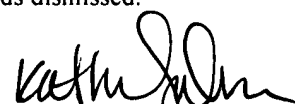
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Commissioner for Patents

The timely submission under 37 CFR 1.129(a) filed on 5/23/2006 is not fully responsive to the prior Office action because the applicant is required to further elect a SPECIFIC probe set combination. For the newly amended claims elected (Claims 8-17) the composition of the first polynucleotide (Seq ID No. 4) and a second polynucleotide (SEQ ID No. 8) will be searched. However, the new claims are further drawn to various combinations of probe sets. Please select which specific probe or which specific probe set to be examined. Each specific probe or specific probe set is drawn to a different combination of sequences. The search for each of these different combinations is a burden for the office. For each group of sequences, the combination elected is examined, not the individual sequences. Though combinations might share some individual sequences, each combination is distinct because it is comprised of a different set of sequences. This further restriction is NOT an election of species. Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequences are presumed to represent an independent and distinct invention, subject to restriction requirement pursuant to 35 USC 121 and 37 CFR 1.141. By statute, "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." 35 U.S.C. 121. Pursuant to this statute, the rules provide that "[i]f two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant...to elect that invention to which his claim shall be restricted." 37 CFR 1.142(a). See also 37 CFR 1.141(a). It is noted that searching more than one of the claimed patentably distinct chromosome and variant base positions represents a serious burden for the office.

Since the submission appears to be a bona fide attempt to provide a complete reply to the prior Office action, applicant is given a shortened statutory period of ONE MONTH or THIRTY DAYS from the mailing date of this letter, whichever is longer, to submit a complete reply. This shortened statutory period supersedes the time period set in the prior Office action. This time period may be extended pursuant to 37 CFR 1.136(a). If a notice of appeal and the fee set forth in 37 CFR 1.17(e) were filed prior to or with the payment of the fee set forth in 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant is construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a). The appeal stands dismissed.


BJ FORMAN, PH.D.
PRIMARY EXAMINER


Katherine Salmon
Examiner
Art Unit 1634